

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed March 11, 2008. Reconsideration and allowance of the application and pending claims are respectfully requested.

#### **Objection to claim 3**

In the office action, claim 3 was objected to for the informality of term "enamelled" (line 2).

In response, referring to amendments to the claims, Applicant has corrected the formal mistake of "enamelled" to "enameled" as required by the examiner. Applicant respectfully submits that the objection with regard thereto is now obviated.

#### **Rejections to claims 1-4**

In the office action, claims 1-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kurogi et al (US 5,396,696) in view of Nuttall et al (US 4,743,331) as well as further in view of Yang (US 6,737,603).

In response, Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following remarks.

**1. The references cited in the rejections cannot be combined to arrive at the invention as claimed in independent claim 1, much less in the manner proposed**

Most if not all inventions arise from a combination of old elements. Therefore, every element of a claimed invention may be found in the prior art. However, identification in the prior art of each individual element claimed is insufficient to defeat patentability of the claimed invention as a whole. Rather, to establish obviousness based on a combination of the elements in the prior art, there must be some motivation, suggestion or teaching whereby one ordinary skilled in the art would have selected the components as that the inventor selected and used them to arrive at the claimed invention. In other words, Examiner must show reasons that one of ordinary skill in the art, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the prior art for combination in the manner as claimed.

However, in the office action, Examiner has only selected some elements from the cited references as listed, i.e. the coil winder, the locator of inductor and the spot electric welder of US 5,396,696, the brushless DC motor and a connecting pole of US 4,743,331, and the digital display screen of US 6,737,603. There is no indication why these elements can be combined to arrive at the subject matter as claimed in independent claim 1 in the manner as proposed.

Therefore, Applicant respectfully submits that Examiner failed to present any suggestion or teaching that may motivate one of ordinary skill in the art to combine the cited references to arrive at the subject matter as claimed in independent claim 1 of the present patent application, much less in the manner proposed. The combination of the cited references as proposed by the Examiner is improper and illogical.

Actually, the combination of all of the individual elements from different cited dereferences itself needs creative work of one ordinary skill in the art. It is also one of the most considerable and notable inventive steps of the subject matter as claimed in independent claim 1.

In light of the proceeding remarks, Applicant respectfully submits that the invention as claimed in independent claim 1 of the present patent application is unobvious and patentable over the cited references or any combination thereof and, therefore, the rejections regarding thereto should be withdrawn for at least this reason.

**2. The combination of the cited references in the manner as proposed still fails to disclose certain technical features as distinctly recited in independent claim 1**

As explicitly cited in independent claim 1, the apparatus for producing an electronic inductor includes a locator of inductor (referring to reference numeral 2 in Fig. 1). The locator is located under a welding head of the spot electric welder and a jig of the welding head. The locator of inductor connects with a brushless DC motor via a connecting pole (referring to reference numeral 8 in Fig. 1).

However, none of the cited references discloses the features of "the locator of the inductor" and "the connecting pole", much less the relationship between the locator of the inductor and the spot electric welder. Therefore, it is also impossible for one of ordinary skill in the art to bring these features in the cited references together to arrive at the invention as claimed in independent claim 1. Understandably, even if the cited

references can be combined in the proposed manner, modification or alteration is still needed to arrive at the invention as claimed in independent claim 1.

### **3. The invention as claimed in independent claim 1 has new technical effect**

Referring to the descriptions in paragraph [0010] of the present application, the apparatus for producing electronic inductor as defined in independent claim 1 can simplify manufacturing and testing process of the electronic inductor. More particularly, the arrangement of detachably holding the electronic inductor in the locator can allow the electrical testing of the electronic inductor to be performed within a single mounting arrangement, which is also used for the winding and welding process.

Where function of the combined technical features are mutually supported and have obtained a new technical effect, i.e. the technical effect after combination is better than the total effects of each technical feature, such invention should be deemed to possess prominent substantive features and notable progress. Whether or not each technical feature is known or partially known does not affect the inventiveness.

Accordingly, independent claim 1 is respectfully submitted to be unobvious and patentable over the cited references or any combination thereof, and withdrawal of the rejections relative thereto and allowance of the independent claim 1 are respectfully requested.

Claims 2 to 4 are directly dependent to independent claim 1. Each of them not only recites all the features recited in independent claim 1, but also adds additional feature(s), respectively. Since independent claim 1 is patentable over the cited references or any combination thereof, dependent claims 2 to 4 directly dependent

thereon should also be patentable over the cited references and in condition for allowance.

#### **Remarks on Newly Added claims 5-14**

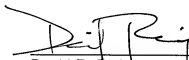
In the response, the applicant has also added a new set of claims 5-14. Applicant respectfully submits that the Newly Added claims are all based on the whole disclosure of the description and the appended drawings. No new material is introduced.

Similar to the forgoing remarks regarding to claims 1-4, Applicant respectfully submits that the subject matter as claimed in claims 5-14 are patentable over the cited references or any combination thereof at least based on the citation of "the locator", "the recess defined in the middle of the locator for detachably holding the electronic inductor therein" as well as "the connecting pole", in view of the foregoing remarks with regard to claims 1-4.

### **Conclusions**

In light of the foregoing, Applicant respectfully submits that all the claims of the present patent application are patentable over the cited references or any combination thereof and in condition for allowance. An act to this effect on an earlier date is earnestly requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
\_\_\_\_\_  
David R. Risley  
Registration No. 39,345

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1500  
600 Galleria Parkway S.E.  
Atlanta, Georgia 30339  
(770) 933-9500